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| EXAMINER |
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SNOW, BRUCE EDWARD

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3738

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/675,064
Filing Date: September 30, 2003
Appellant(s): BARNETT ET AL.

MAILED
SEP 06 2006
GROUP 3700

Paul Maginot
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 21, 2006 appealing from the Office action mailed January 19, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|-----------------|---------|
| 5,645,607 | Hickey | 7-1997 |
| 6,149,687 | Gray, Jr. et al | 11-2000 |

| | | |
|--------------|----------------|---------|
| 2004/0220673 | Pria | 11-2004 |
| 2005/0256583 | Bouttens et al | 11-2005 |
| 5,776,200 | Johnson et al | 7-1998 |
| 5,702,464 | Lackey et al | 12-1997 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding at least claims 21 and 28, applicant is purposely confusing the couplers terminology. The coupler names are not consistent and not supported.

Claim 22 is indefinite, the retroversion component does not have a fifth coupler. What is the "additional bone component"? Is it supported in the specification?

Claim 29, what is the "additional bone component"? This seems to be different than claim 22.

Claims 21 and 25-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Hickey (5,645,607).

Appellant's arguments are persuasive, the rejection has been withdrawn.

Claims 28, 29, 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gray, Jr. et al (6,149,687).

The following is copied from the rejection under 35 U.S.C. 103(a) below:

21. (New) A modular long bone prosthesis, comprising:
a proximal component 32 having a second coupler 36 at a distal end thereof,
a retroversion component 10 having third coupler (bolt) at a proximal end thereof
and a fourth coupler (element 10 has a larger diameter at the bottom interpreted as the
fourth coupler capable of coupling to a bone canal centering anchor) at a distal end
thereof, said third coupler being configured to mate with said second coupler of said
proximal component so as to retain said retroversion component in fixed relation to said
proximal component,

wherein said one of said proximal component and said retroversion component
has a tab 28, and wherein the other one of said proximal component and said
retroversion component has a first slot 48 and a second slot 46,

wherein said proximal component and said retroversion component are
configurable between a right long bone mode and a left long bone mode (see figures 3
and 4),

wherein when in said right long bone mode (i) said second coupler of said
proximal component is positioned in mating relationship with said third coupler of said
retroversion component, (ii) said tab is positioned in said first slot, and (iii) no tab is
positioned in said second slot, and

wherein when in said left long bone mode (i) said second coupler of said proximal component is positioned in mating relationship with said third coupler of said retroversion component, (ii) said tab is positioned in said second slot, and (iii) no tab is positioned in said first slot.

Claims 21, (26 removed), and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray, Jr. et al (6,149,687).

Gray et al teaches:

21. (New) A modular long bone prosthesis, comprising:
a proximal component 32 having a second coupler 36 at a distal end thereof,
a retroversion component 10 having third coupler (bolt) at a proximal end thereof
and a fourth coupler (element 10 has a larger diameter at the bottom interpreted as the fourth coupler capable of coupling to a bone canal centering anchor) at a distal end thereof, said third coupler being configured to mate with said second coupler of said proximal component so as to retain said retroversion component in fixed relation to said proximal component,

wherein said one of said proximal component and said retroversion component has a tab 28, and wherein the other one of said proximal component and said retroversion component has a first slot 48 and a second slot 46,

wherein said proximal component and said retroversion component are configurable between a right long bone mode and a left long bone mode (see figures 3 and 4),

wherein when in said right long bone mode (i) said second coupler of said proximal component is positioned in mating relationship with said third coupler of said retroversion component, (ii) said tab is positioned in said first slot, and (iii) no tab is positioned in said second slot, and

wherein when in said left long bone mode (i) said second coupler of said proximal component is positioned in mating relationship with said third coupler of said retroversion component, (ii) said tab is positioned in said second slot, and (iii) no tab is positioned in said first slot.

However, Gray et al is unclear regarding a head component and a coupling means (first and fifth couplers). It would have been obvious to one having ordinary skill in the art to include a head component (insert or articulating component) and a coupling means such that the system could be fully sized and trialed.

(10) Response to Argument

Claims 21-28 are rejected under 35 U.S.C. 112, second paragraph.

Appellant concedes the various coupler terminology changes between the groups of claims; the Examiner finds this confusing especially given the fact that the language is not supported in the specification.

Regarding the rejection of claims 22 and claim 29, appellant is not appealing these claims, however, has not cancelled them either.

Claims 21 and 25-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Hickey (5,645,607).

Appellant's arguments are persuasive, the rejection has been withdrawn.

Claims 28, 29, 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gray, Jr. et al (6,149,687).

Appellant is not appealing claims 28 or 29 but has not cancelled them either.

Regarding claim 32, appellant argues the slots 46 and 48 are not positioned adjacent to each other. OneLook dictionary defines adjacent as:

adjective: near or close to but not necessarily touching (Example: "*Lands adjacent to the mountains*")

It is the Examiner's position that slots 46 and 48 are "near or close to but not necessarily touching" and are correctly defined as being positioned adjacent to each other.

Claims 21, (26 removed) and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray, Jr. et al (6,149,687).

Gray positively recites all elements, however, Gray et al is unclear regarding a head component and a coupling means (first and fifth couplers). It is the Examiner's strong position that it would have been obvious to one having ordinary skill in the art to include a head component (insert or articulating component) and a coupling means such that the system could be fully sized and trialed. Appellant states, "there does not appear to exist a teaching, suggestion, or incentive in the prior art which supports the proposed modification of Gray, Jr. et al." The Examiner hereby cites Johnson et al

(5,776,200) and Lackey et al (5,702,464) as official notice which teach trial systems similar to Gray, Jr. et al both having a head component (insert) 13 and 11, respectively, with coupling means. The combination is believed to be very obvious to one having ordinary skill in the art.

Appellant additionally argues that a tibial insert is not a head component such as a head of the femur or the head of a humerus. The Examiner was unable to find a definition of a head component in appellant's specification. Additionally, it is known in the art that a prosthetic humerus can have a convex or concave shape. The Examiner cites Bouttens et al (2005/0256583) and Pria (2004/0220673), both teaching replacing the bone head of a humerus with a concave component. Therefore, these concave components replacing a convex bone head are prosthetic head components. Therefore, the Examiner has to give the claim language its broadest reasonable interpretation to include shapes other than convex; or possibly being simply the articulating component of the joint, or the top component in a system.

Appellant's arguments regarding claim 26 is persuasive.

Regarding the rejection of claims 28-31, appellant is not appealing these claims, however, has not cancelled them either.

(11) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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